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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/711,261	11/10/2000	John DeMayo	08011.3010-00000	6688

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EXAMINER	
CHAMPAGNE, DONALD	
ART UNIT	**PAPER NUMBER**
3622	

MAIL DATE	DELIVERY MODE
02/26/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/711,261	DEMAYO ET AL.	
	Examiner	Art Unit	
	Donald L. Champagne	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 October 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-32* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-32* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *10 November 2000* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Reopening of Prosecution following Remand by the BPAI

1. In view of the decision by the Board of Patent Appeals and Interferences on 29 October 2007 (pp. 11-12), PROSECUTION IS HEREBY REOPENED. A new non-final rejection is set forth below.

2. To avoid abandonment of the application, appellant must exercise one of the following two options:

   (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

   (2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

   A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing on the last page of this action.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

   > (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-7, 9-15, 21, 22, 24, 25 and 31 are rejected under 35 U.S.C. 102(e) as being unpatentable over Bull et al. (US005995943A) in view of Rodkin et al. (US006092074A).

5. Bull et al. teaches (independent claims 1, 9, 21 and 24) an apparatus and method for hyperlinking specific words in content or in text-containing files, or displayed in an application, to convert the words into advertisements, the method comprising: connecting a

content provider server to the Internet, said content provider having content files to be displayed (col. 3 lines 31-34 and 66-67); providing an advertiser web page so as to be accessible over the Internet (the *Advertising DataStore* ***250***, col. 12 lines 32-34 and Fig. 2); and connecting an ad server (*advertiser's computer system* ***400***, col. 8 line 10 and Fig. 1) to the Internet, wherein the ad server provides *hot links* (col. 8 line 19-21), which reads on hypertext links or hyperlinks (Microsoft Press Computer Dictionary), to convert at least one existing word (e.g., *Holiday Inns on the West Coast*, col. 15 lines 39-42) present in a content file into one or more advertisements (e.g., an ad for *Hilton Inns on the West Coast*) by linking an Internet-enabled web browsing device (*network addressable interface device*, col. 3 lines 28-29) connected to the Internet to said advertiser web page (col. 15 lines 30-33). Bull et al also teaches the hypertext link at col. 3 lines 56-58. Bull et al. also teaches (claims 1 and 21) a terminal (*user access system* ***100***) for connection to the Internet.

6. Bull et al. also teaches that said word or phrase is advertiser-chosen. The reference teaches that the advertiser chooses the criteria by which the ads are placed (col. 8 lines 3-5 and 19-22), said advertiser-chosen criteria being used to choose said word(s) (col. 15 lines 24-29).

7. Bull et al. does not teach means for providing a hypertext anchor to convert at least one existing advertiser-chosen word present in a content file into an advertisement by linking said at least one advertiser-chosen word to said advertiser web page. Rodkin et al. teaches means (*The Intelligent Annotator*^{TM}, col. 15 lines 36-42) for providing a hypertext anchor to convert at least one existing advertiser-chosen word (*various character strings relating to movies*, col. 14 lines 3-20, where *a particular organization* reads on the "advertiser") present in a content file into an advertisement by linking said at least one advertiser-chosen word to said advertiser web page (*that organization's Web page*). Because Rodkin et al. teaches that this provides facile updating and other features not present with static linking (col. 3 lines 35-44), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Rodkin et al. to those of Bull et al.

8. In addition, under *KSR v. Teleflex* (82 USPQ 2nd 1385), the combination would be obvious because it is a simple substitution of one known element for another to obtain predictable results. Rodkin et al. teaches dynamic links that can be readily substituted for the static links taught by Bull et al.

9. Bull et al. does not explicitly teach (independent claim 31) displaying a description of the advertiser web page when a mouse pointer is positioned over the hyperlink. However, under the principles of inherency (MPEP § 2112.02), since the reference invention necessarily performs the method claimed, the method claimed is considered to be anticipated by the reference invention. As evidence tending to show inherency, the reference teaches clicking on a URL (col. 14 lines 50-52), in order to access a Web page. The mouse pointer must inherently be positioned over the URL link in order to activate said link by clicking on it.

10. Bull et al. also teaches at the citations given above claims 2, 4-6, 10, 12 and 13.

11. Bull et al. does not teach (claims 3, 11, 22 and 25) using a script to provide a hypertext anchor and (claims 7 and 14-15) using frames to display the content provider URL in a browser window. It was common, at the time of the instant invention, to use script to provide a hypertext anchor and display the URL of content in a browser window using frames. Because it is efficient to use common and well known practices, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Bull et al. the use of script to provide a hypertext anchor and the use of frames to display the content provider URL in a browser window.

12. Official notice of this common knowledge or well known in the art statement was taken in the Office action mailed 2 August 2004 (para. 11). This statement is taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of official notice or that the traverse was inadequate. (MPEP 2144.03.C.).

13. Claims 8, 16, 23 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bull et al. in view of Rodkin et al. and further in view of Kirsch et al. (US006189030B1). Neither Bull et al. nor Rodkin et al. teach linking to said advertiser web page using a tracking URL. Kirsch et al. teaches linking to said advertiser web page (*the external server* system, col. 7 lines 10-17) using a tracking server system (col. 5 lines 14-26), which reads on a tracking URL. Because Kirsch et al. teaches that tracking clicks is important (col. 2 lines 34-38 and col. 6 lines 60-61) and that the reference invention does so expediently, with minimum latency and visibility (col. 5 lines 33-37), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add Kirsch et al. to the teachings of Bull et al. and Rodkin et al.

14. Claims 17, 18, 27 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bull et al. in view of Rodkin et al. and further in view of in view of Murray (US006061659A).

15. Neither Bull et al. nor Rodkin et al. teach (independent claims 17 and 27) the advertiser compensating at least one of a content provider and an entity that selects said hypertext anchor. Murray teaches the advertiser compensating at least one of a content provider and an entity that selects said hypertext anchor (col. 8 lines 19-20). Because it facilitates the acceptance of advertising (col. 2 lines 22-24), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add Murray to the teachings of Bull et al. and Rodkin et al.

16. Murray also teaches claims 18 and 28 at the citation given above.

17. Claims 19, 20, 29, 30 and 32 are rejected under 35 U.S.C. 103(a) as being obvious over Bull et al. in view of Rodkin et al. and Murray and further in view of Kirsch et al.

18. Neither Bull et al. nor Rodkin et al. nor Murray teaches (claims 20 and 30) linking to said advertiser web page using a tracking URL. Kirsch et al. teaches linking to said advertiser web page (*the external server* system, col. 7 lines 10-17) using a tracking server system (col. 5 lines 14-26), which reads on a tracking URL. Because tracking clicks is important (col. 2 lines 34-38 and col. 6 lines 60-61) and the reference invention does so expediently, with minimum latency and visibility (col. 5 lines 33-37), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Kirsch et al. to those of Bull et al. and Rodkin et al. and Murray.

19. Kirsch et al. also teaches claims 19, 29 and 32 (col. 2 lines 29-38).

Conclusion

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 9:30 AM to 8 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.

21. The examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone number for all *formal* fax communications is 571-273-8300.

22. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

23. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

11 February 2008

/Donald L. Champagne/
Primary Examiner, Art Unit 3622

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